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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,078	02/27/2002	Anthony J. Baerlocher	0112300/747	2836

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BELL, BOYD & LLOYD LLC
P. O. BOX 1135
CHICAGO, IL 60690-1135

EXAMINER	
CAPRON, AARON J	

ART UNIT	PAPER NUMBER
3714	

DATE MAILED: 07/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/086,078	BAERLOCHER ET AL.
	Examiner	Art Unit
	Aaron J. Capron	3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 April 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10,13,14,17-44 and 47-53* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10, 13-14, 17-44 and 47-53* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

This is a response to the Amendment received on April 27, 2004, in which claims 1, 13, 21, 32, 38, 44, 46 and 52 were amended and claims 11-12, 15-16, 45 and 54-55 were cancelled. Claims 1-10, 13-14, 17-44 and 47-53 are pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-10, 13-14, 17-44 and 47-53 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amended claim language, "wherein the additional selection is picked before the offer associated with the first selection is displayed", does not appear to be disclosed in the specification in such a way as to reasonably convey to the Examiner that the Inventors had possession of the claimed invention. The Applicant is required to specifically point out within the specification the location of the disputed claim language.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3, 6-18, 21-23 and 25-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Punch-a-Bunch/The Punch Board (hereafter "Punch Board").

Punch Board discloses a plurality of player selections; a plurality of offers associated with the selections; at least one display device for displaying the selections and offers to a player; a number of player picks of the selections; randomly associate the offers with the selections; enable the player to select the number of player picks of the selections; sequentially display each offer associated with each selection picked by the player to the player and enable the player to sequentially accept or reject each displayed offer until the player accepts the displayed offer or until the offer associated with all of the selections picked by the player are displayed to the player; and provide the player the displayed offer which is accepted by the player or if not displayed offer is accepted by the player, provide the player the last displayed offer (page 1), but does not disclose the game is run by a processor on the gaming machine. However, it is notoriously well known within the art of gaming machines to incorporate the features of a game show onto a gaming machine in order to attract people who like to watch the game show. One would be motivated to combine the references in order to attract people who like to watch the game show. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the a gaming machine having a game show type, as disclosed by Punch Board, in order to attract people who like to watch the game show.

Referring to claim 2-3, Punch Board discloses the plurality of offers are randomly selected from at least one pool of offers or a predetermined range of offer amounts (page 1).

Referring to claims 6-7, Punch Board discloses a gaming machine with a punchboard type of game, but does not specifically disclose revealing any of the other offers behind the unselected locations on the grid. However, it is notoriously well known within the art of electronic punchboard gaming machines to reveal all awards (offers) behind the locations on the grid in order to allow the player to verify the winning and/or losing outcomes on the grid. One would be motivated to provide the revealed outcomes of the whole grid to the player in order to entice the player to play the game longer to win the big prize. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the revealed outcomes of the whole grid to the player into the gaming machine of Punch Board in order to entice the player to play the game longer to win the big prize.

Referring to claim 8, Punch Board discloses the offers are associated with each picked selection are sequentially displayed in the order picked by the player.

Referring to claims 9-10, Punch Board discloses the selection are sequentially displayed by the order picked by the player, but do not disclose being in reverse order or a random order. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to be able to display the offers in any order to allow the player the control to affect the offer outcome. One would be motivated to display the offer in any order to allow the player the control to affect the offer outcome. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to display the offers in any order to allow the player the control to affect the offer outcome.

Referring to claims 11-16, Punch Board discloses a second chance slip that allows a player to punch another hole and the two slips are added together (page 1, third paragraph).

Referring to claim 17, Punch Board discloses means for determining the number of player picks of the selections. Punch Board discloses the ability to receive an additional pick if a selection is made on the Punch Board that states that there is a Second Chance (Page 1, third paragraph).

Referring to claims 18, Punch Board discloses a plurality of player selectable masked symbols (selections on the Punch Board) and player picks associated with the selections on the Punch Board, wherein the number of player picks of the selections is at least based on the picks associated with one of the masked selections picked by the player. If a player gets a "Second Chance" slip the number of player selections will increment.

Claims 21-23 and 25-31 correspond in scope to a gaming device set forth for use of the gaming device listed in the claims above and are encompassed by use as set forth in the rejection above. Referring to claim 21, Punch Board discloses that the award is provided to a player after the player picks a plurality of selections.

Claims 32-37 correspond in scope to a gaming device set forth for use of the gaming device listed in the claims above and are encompassed by use as set forth in the rejection above.

Claims 38-43 correspond in scope to a gaming device set forth for use of the gaming device listed in the claims above and are encompassed by use as set forth in the rejection above.

Claims 44-45 correspond in scope to a gaming device set forth for use of the gaming device listed in the claims above and are encompassed by use as set forth in the rejection above.

Claims 46-48 correspond in scope to a gaming method set forth for use of the gaming device listed in the claims above and are encompassed by use as set forth in the rejection above. The Examiner views a player initiating play at a gaming machine as triggering a game. The number of player picks in the game Punch Board is determined by a sub-game.

Referring to claims 49-51, Punch Board as a gaming machine is disclosed above, but does not disclose that is provided over a data network, such as the Internet. However, it is notoriously well known in the art to provide casino games over the Internet in order to attract players that cannot physically travel to a casino. One would be motivated to provide the casino game Punch Board over the Internet in order to attract players that cannot physically travel to a casino. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a casino game onto the Internet in order to attract players that cannot physically travel to a casino.

Claims 52-55 correspond in scope to a gaming method set forth for use of the gaming method and device listed in the claims above and are encompassed by use as set forth in the rejection above.

Claims 4-5, 24 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Punch Board in view of Mayeroff (U.S. Patent No. 6,231,442).

Punch Board discloses a punchboard gaming machine having a number of player picks dependent, but does not disclose how the player picks are determined with respect to a gaming machine. However, Mayeroff discloses a gaming machine having a punchboard bonus game triggered by a base game wherein the number of player picks in the bonus game is dependent

upon the random outcome of indices appearing on a pay line or by a predetermined number of coins that a player inputs into the base game of the gaming machine (3:50-56). One would be motivated to provide Mayeroff's gaming machine having the bonus game's number of picks being determined by a base game into the gaming machine of Punch Board disclosed above in order to encourage player to play more pay lines since the player would receive more chances at the bonus game based upon the amount the player puts into the machine (3:57-64). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a punchboard bonus game number of picks being determined by the base game, as disclosed in Mayeroff, into the gaming machine of Punch Board in order to encourage players to play more pay lines.

Claims 17-20, 30-31, 35-37, 41-43 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Punch Board in view of Mayeroff as applied to claims 4-5, 24 and 47 above, and further in view of Walker et al. (U.S. Patent No. 6,174,235; hereafter "Walker"), wherein the masked symbols are not the Punch Board selections.

Punchboard in view of Mayeroff discloses a gaming machine having a base game that initiates the bonus Punch Board game; wherein a combination of symbols in the base game can determine the number of player selections in the bonus game (3:50-56), but does not disclose that each masked symbols are associated with a plurality of picks. However, Walker discloses a gaming machine wherein the typical slot reels are altered in a manner to form a punchboard type of game that take a combination of symbols to form an outcome (2:56-3:15) that allows a player an illusion of control over the gaming machine (2:49-50). One would be motivated to combine

the references in order to give the player an illusion of control over the gaming machine of Punch Board and Mayeroff. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a punchboard type of game in place of a slot reel game, as disclosed by Walker into the gaming machine of Punchboard and Mayeroff in order to give the player an illusion of control.

Response to Arguments

Applicant's arguments filed April 27, 2004 have been fully considered but they are not persuasive. The following statements are incorporated into the rejection above.

Applicants argue that PAB does not disclose, teach or suggest enabling the player pick at least one additional selection if the first selection is selected, wherein the additional selection is picked before the offer associated with the first selection is displayed. However, Applicants use an "if" conditional statement within their claim language that fails to further limit the claim language in a manner that would distinguish over the obviousness rejection of PAB. PAB fully discloses the amended language when the additional selection is associated with the second selection. Further, the claim language is not so limiting as to exclude the player having four picks, the four picks being one Second Chance and three player selectable selections, wherein the additional player pick is the first pick chosen by a player and the three player selectable selections include the Second Chance award and the two player selectable selections. In addition, the order of the additional pick and its associated player pick lack criticality since the product or the addition of the two would equate to the same value (A*B=B*A; or A+B=B+A). Therefore, the claimed invention fails to preclude the invention of PAB.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron J. Capron whose telephone number is (703) 305-3520. The examiner can normally be reached on M-Th 8-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on (703) 308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ajc

JOHN M. HOTALING, II
PRIMARY EXAMINER